UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,240	11/30/2000	Marc S. Phillips	PA990382	4366

23696	7590	11/18/2003

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER
DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
2681	4

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)	
Office Action Summary	09/727,240		PHILLIPS, MARC S.	
	Examiner		Art Unit	
	Temica M. Davis		2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 November 2000_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-26_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-26_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

2.   Claims 1, 2, 5-23 and 26 are rejected under 35 U.S.C. 102(e) as being

anticipated by Aoki, U.S. Patent No. 6,580,928.

Regarding claim 1, Aoki discloses a method of programming a macro to

selectively operate features of a personal wireless communication handset, the method

comprising the steps of: initiating a program mode in a controller of the handset;

entering a sequence of inputs using a user interface; storing said sequence of inputs in

a memory; and defining a procedure for retrieving the sequence of inputs from the

memory to operate at least one selected feature of the handset (col. 3, line 4-col. 5, line

32).

Regarding claim 2, Aoki discloses the method of claim 1 wherein the user

interface is a keypad (col. 3, lines 40-43; figure 3).

Regarding claim 5, Aoki discloses the method of claim 2 wherein the procedure

for retrieving the sequence of inputs uses a dedicated hot key (col. 3, lines 40-59).

Regarding claim 6, Aoki discloses the method of claim 2 wherein the procedure for retrieving the sequence of inputs uses a soft key (col. 3, lines 40-59).

Regarding claim 7, Aoki discloses the method of claim 2 wherein the procedure for retrieving the sequence of inputs uses an overridden key on said keypad (col. 3, lines 40-59).

Regarding claim 8, Aoki discloses the method of claim 1 wherein a menu list displays macros stored in said memory (col. 3, lines 48-59, col. 4, lines 14-51).

Regarding claim 9, Aoki discloses the method of claim 8 wherein the menu list displays the defined procedure for retrieving a macro (col. 3, lines 48-59, col. 4, lines 14-51).

Regarding claim 10, Aoki discloses the method of claim 1 wherein the macro operates a selected plurality of features (col. 3, line 40-col. 5, line 31).

Regarding claim 11, Aoki discloses a personal communication handset comprising: a display; a user-interface; a controller coupled to the display and configured to communicate with said display so as to display a set of text descriptions allowing a user to view features of the personal communication handset, said controller also coupled to the user-interface and configured to receive commands from said user-interface to access features of said personal communication handset; a memory device coupled to the controller, such that said controller can retrieve data stored on said memory device; and a macro program stored in the memory device, said macro program comprising a set of user-interface inputs for controlling at least one feature of the wireless communications device (col. 3, line 4-col. 5, line 32).

Regarding claim 12, Aoki discloses the personal communication handset of claim 11 wherein the user-interface is a keypad (col. 3, lines 40-43; figure 3).

Regarding claim 13, Aoki discloses the personal communication handset of claim 12 further comprising a dedicated macro hot key on said keypad, the macro hot key configured to initiate the macro program (col. 3, lines 40-59).

Regarding claim 14, Aoki discloses a personal communication handset comprising: a display; a user-interface; a controller in electrical communication with said display so as to cause said display to display a set of text descriptions defining features of the personal communication handset, said controller also receiving commands from said user-interface causing the controller to access features of said personal communication handset; a memory device coupled to the controller, such that said controller can retrieve data stored on said memory device; and a program stored in the memory device for storing a sequence of inputs entered using the user-interface and for retrieving said sequence of inputs to control at least one feature of the personal communication handset (col. 3, line 4-col. 5, line 32).

Regarding claim 15, Aoki discloses the personal communication handset of claim 14 wherein the user-interface is a keypad (col. 3, lines 40-43; figure 3).

Regarding claim 16, Aoki discloses the personal communication handset of claim 15 further comprising a dedicated macro key on the keypad configured to initiate the procedure to retrieve the sequence of inputs (col. 3, lines 40-59).

Regarding claim 17, Aoki discloses a method of selectively operating features of a personal wireless communication handset, the method comprising the steps of:

initiating a program mode in a controller of the handset; entering a sequence of inputs using a keypad on the handset; storing said sequence of inputs in a memory; defining a procedure for retrieving the sequence of inputs from the memory; and pressing a key on the keypad to initiate the procedure for retrieving the sequence of inputs from the memory to operate selected features of the handset (col. 3, line 4-col. 5, line 32).

Regarding claim 18, Aoki discloses the method of claim 17 where the key on the keypad pressed to perform the macro is a dedicated hot key (col. 3, lines 40-59).

Regarding claim 19, Aoki discloses the method of claim 17 where the key on the keypad pressed to perform the procedure is a soft key (col. 3, lines 40-59).

Regarding claim 20, Aoki discloses a personal wireless communication handset comprising: a display; a keypad comprising a macro hot key; a controller coupled to the display and configured to communicate with said display so as to display a set of text descriptions allowing a user to view features of the personal wireless communication handset, said controller also coupled to the keypad and configured to receive commands from said keypad to access features of said personal wireless communication handset; a memory device coupled to the controller, such that said controller can retrieve data stored on said memory device; and a macro program stored in the memory device, said macro program comprising a set of keypad inputs to control at least one feature of the wireless communications device, wherein the macro program is initiated by pressing a macro hot key (col. 3, line 4-col. 5, line 32).

Regarding claim 21, Aoki discloses a personal communication handset comprising: means for initiating a program mode in a controller of the handset; means

for entering a sequence of inputs using a user interface; means for storing said

sequence of inputs in a memory; means for defining a procedure for retrieving the

sequence of inputs from the memory; and means for initiating the procedure for

retrieving the sequence of inputs from the memory so that the macro is performed to

operate at least one selected feature of the handset (col. 3, line 4-col. 5, line 32).

Regarding claim 22, Aoki discloses a method of operating a specified feature of a

personal wireless communication handset, the method comprising the steps of:

programming a macro for operating a specified feature of the handset comprising the

steps of: initiating a program mode in a controller of the handset; entering a sequence of

inputs using a user interface; storing said sequence of inputs in a memory; and defining

a procedure for retrieving the sequence of inputs from the memory to operate the

selected feature of the handset; and initiating operation of the macro so as to operate

the specified feature of the handset (col. 3, line 4-col. 5, line 32).

Regarding claim 23, Aoki discloses the method of claim 23 wherein the user

interface is a keypad (col. 3, lines 40-43; figure 3).

Regarding claim 26, Aoki discloses the method of claim 24 wherein the

procedure for retrieving the sequence of inputs uses a dedicated hot key (col. 3, lines

40-59).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki in view of Son et al (Son), U.S. Patent No. 6,212,408.

Regarding claims 3 and 24, Aoki discloses the method of claims 1 and 23 as described above. Aoki, however, fails to disclose wherein the user interface is voice recognition device.

In a similar field of endeavor, Son discloses a voice command system and method. Son further discloses a communication device that accesses menu features/commands by using voice commands (col. 1, line 60-col. 2, line 64).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Aoki with the teachings of Son for the purpose of implementing hands-free operation of a mobile terminal, thereby freeing up the hands of a user in order to perform other tasks such as driving a vehicle.

5. Claims 4 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki and Reber et al (Reber), U.S. Patent No. 6,002,946.

Regarding claims 4 and 25, Aoki discloses the method of claims 1 and 23 as described above. Aoki, however, fails to disclose wherein the user interface is a stylus device.

In a similar field of endeavor, Reber discloses a handheld device having an optical data reader. Reber, further discloses wherein the handheld device has a stylus user interface that is used to initiate commands (col. 2, lines 34-42).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Aoki with the teachings of Reber since stylus type interfaces are well known devices used to access/initiate commands.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hitchings, Jr, U.S. Patent No. 6,594,484, discloses an automated access by mobile device to automated telephone information services.

Hutchison, IV et al, U.S. Patent No. 6,449,476, discloses a system and method for independently downloading features into a set of storage locations in a wireless communication device.

Kim, U.S. Patent No. 6,370,519, discloses a method for storing and displaying telephone numbers of communication terminals.

Cushman et al, U.S. Patent No. 6,125,287, discloses a wireless telephone having an improved user interface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703) 305-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

TMD
November 16, 2003

TEMICA M. DAVIS
PATENT EXAMINER